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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,499	10/27/2003	Mark Roby	2872	2661
7590	04/28/2004		EXAMINER GORR, RACHEL F	
Mark Farber C/O Tyco Healthcare Group LP 150 Glover Avenue Norwalk, CT 06856			ART UNIT 1711	PAPER NUMBER

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,499

Applicant(s)

ROBY, MARK

Examiner

Rachel F. Gorr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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1. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 3 is broader in scope than claim one by listing diisocyanates that aren't para in configuration, such as 2,4 TDI and 2,4' MDI.

2. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 7 are confusing because the preceding claims doesn't have an antecedent basis for the term "electron withdrawing group".

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 9-15, 17-19 and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuda.

Matsuda (534) discloses an adhesive comprising an NCO-terminated hydrophilic urethane prepolymer which is made from para-phenylene diisocyanate (PPDI) (see examples). The examples show the prepolymer prepared from polyethers having equivalent weights within the specified range of the claims and comprising at least 80 % ethylene oxide reacted with the initiators of the claims (col. 1, lines 46-68). In col. 4, lines 50-63, he shows the fillers, softening agents and stabilizers of the claims. He teaches using his adhesive for medical purposes (col. 5, lines 20-28).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 4-8, 16, 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda (534) in view of Matsuda (542) and Trischler.

7. Matsuda (534) discloses the invention of the claims (see above) but differs from these claims by not requiring substituted polyisocyanates and by not showing physiologically active materials.

8. Matsuda (542) discloses surgical hydrophilic adhesives comprising NCO prepolymers made from polyether polyols with high oxyethylene content and fluorine-containing polyisocyanate (col. 1, lines 46-49). In col. 3, line 12, he discusses the low toxicity of PPDI. At the bottom of col. 5, he discloses including the physiologically active materials of the claims in his adhesive.

9. Trischler (example 1) discloses using tetrafluoro PPDI for polyether prepolymer adhesives. At the bottom of col. one-top col. 2, he teaches that polyurethanes comprising fluorine-containing diisocyanates are stable in the presence of acids, alkalai, chemicals and oxidizing agents.

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the physiological additives of Matsuda (542) in the surgical adhesives of Matsuda (534) in order to use the adhesive deliver medication at the same time as it's adhering tissues. It would have been obvious to use tetrafluoro

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PPDI because Trischler teaches that it improves the stability of adhesives and Matsuda (542) teaches that fluorinated polyisocyanates are appropriate in surgical adhesives.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 571-272-1072. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.G.
April 26, 2004


RACHEL GORR
PRIMARY EXAMINER